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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,835	07/25/2003	Brian C. Betz	BCB-101A	3733

7590

06/29/2004

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EXAMINER
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LOPEZ, MICHELLE

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/627,835	Applicant(s) BETZ, BRIAN C.	
	Examiner Michelle Lopez	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/25/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it includes more than 150 words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Drawings***

2. The drawings are objected to as obviously informal. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 12-20 are objected to because of the following typographical informalities: in claim 12, line 12, it should read "taper" instead of "tape". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1- 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 and 11, it is not clear what is meant by: "tapered outwardly toward said bottom".

Also, in claim 12, it is not clear what is meant by: "tapered inwardly toward said bottom".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5 and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen (US 6,676,001). Chen'001 discloses a member "21" with a top at the vicinity of "217", a bottom "218", circular sidewalls (see Fig. 3), an upper hollow portion at the rear end of "212" having a cylindrical shape, a lower hollow portion with a cylindrical shape via walls "211'" with a diameter section less than the diameter section of the upper hollow portion (see Fig. 4), the upper hollow portion and the lower hollow portion being connected forming a passage "212" through the member "21", and a lower portion with two tapers (not shown numerically) that are tapered outwardly toward the bottom one opposite to the other (see Fig. 4), wherein the two tapers are flat planar.

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Chen'001 also discloses a nail gun (see fig. 3), a power source "311", a nail feeder at the vicinity of "41", a firing tip via "2" having a cylindrical outer shape with a fixed diameter.

With regards to claim 5, it is deemed that the planer tapers form an angle of about 20° to 45° with the bottom.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 6,676,001) in view of Roy (US 2,169,433). Chen'001 discloses the claimed invention except for providing one of the two tapers as concave curved taper having a fixed diameter. However, Roy'433 teaches a member "11" with a concave curved taper "14" having a fixed diameter for the purpose of adapting the curved taper to receive a tongue of a floor board, wherein holding the device correctly positioned with respect to the tongue of the board during a nail driving operation (see col. 2, lines 15-22). It would have been obvious to one having ordinary skills in the art at the time the invention was made to provided Chen's invention with one of the tapers as a concave curved taper having a predetermined diameter, as taught by Roy'433, in order to adapting the curved taper to receive a tongue of a floor board, thereby holding the device correctly positioned with respect to the tongue of the board during a nail driving operation.

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With regards to claim 9, Chen'001 does not specifically disclose that the member "21" is made of a material selected from the group consisting of metal, plastic, and rubber. However, it would have been obvious to one having ordinary skills in the art at the time the invention was made to make a member "21" from a material selected from the group consisting of metal, plastic, and rubber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because it is old and well-known in the art that different materials such as metal, plastic, and rubber had been used in the manufacturing of nailing gun adapter members, i.e. noise-pieces, nail positioning members, nail feeding or guiding members, as they are less costly and have physical properties that would efficiently function in a nail driving operation.

7. Claims 12-15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 6,676,001) in view Thornton (US 2,660,727). Chen'001 discloses a member "21" with a top at the vicinity of "217", a bottom "218", circular sidewalls (see Fig. 3), an upper hollow portion at the rear end of "212" having a cylindrical shape, a lower hollow portion with a cylindrical shape via walls "211'" with a diameter section less than the diameter section of the upper hollow portion (see Fig. 4), the upper hollow portion and the lower hollow portion being connected forming a passage "212" through the member "21", and a lower portion with two tapers (not shown numerically) that are tapered outwardly toward the bottom one opposite to the other (see Fig. 4), wherein the two tapers are flat planar.

Chen'001 also discloses a nail gun (see fig. 3), a power source "311", a nail feeder at the vicinity of "41", a firing tip via "2" having a cylindrical outer shape with a fixed diameter, wherein the diameter of the upper hollow portion is fitted to the firing tip via the coupling end "217". Chen'001 does not disclose that at least one taper is tapered inwardly toward the bottom of the member. So far claim 12 is understood, Thornton'727 teaches at least one taper (not shown numerically) that is tapered inwardly toward the bottom side of the member "39" for the purpose of positioning the adapter member "39" against or over a groove edge, thereby assuring a proper position and accuracy of a nail during a nail driving operation. In view of Thornton'727, it would have been obvious to one having ordinary skills in the art to have provided a one taper tapered inwardly toward the bottom side of an adapter member in order to position the adapter member against or over a groove edge, thereby assuring a proper position and accuracy of a nail during a nail driving operation.

With regards to claim 19, Chen'001 does not specifically disclose that the member "21" is made of a material selected from the group consisting of metal, plastic, and rubber. However, it would have been obvious to one having ordinary skills in the art at the time the invention was made to make a member "21" from a material selected from the group consisting of metal, plastic, and rubber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because it is old and well-known in the art that different materials such as metal, plastic, and rubber had been used in the manufacturing of nailing gun adapter members, i.e. noise-pieces, nail positioning



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members, nail feeding or guiding members, as they are less costly and have physical properties that would efficiently function in a nail driving operation.

8. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen'001 as applied to claims 12 and 14 above, and further in view of Roy (US 2,169,433). Chen'001 as modified by Thornton'727 disclosed the claimed invention except for providing one of the two tapers as a concave curved taper having a fixed diameter. However, Roy'433 teaches a member "11" with a concave curved taper "14" having a fixed diameter for the purpose of adapting the curved taper to receive a tongue of a floor board, wherein holding the device correctly positioned with respect to the tongue of the board during a nail driving operation (see col. 2, lines 15-22). It would have been obvious to one having ordinary skills in the art at the time the invention was made to provided Chen's invention as modified by Thornton'727 and further modified to include at least one taper as a concave curved taper having a predetermined diameter, as taught by Roy'433, in order to adapting the curved taper to receive a tongue of a floor board, thereby holding the device correctly positioned with respect to the tongue of the board during a nail driving operation.

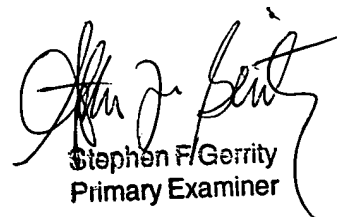
### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Crandall'547, Bacon'354, Sillars'247, Gehl'176, Yost'058, Burton'260, Billing'092, and Stich'239 are cited to show related inventions.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 703-305-8205. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML



Stephen F. Gerrity  
Primary Examiner